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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,532	09/22/2003	Naran Patel		6543

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/664,532	Applicant(s) PATEL, NARAN	
	Examiner Robert Sellers	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 9,13,18 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10-12,14-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/20/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- a) The polymers.
- b) The monomers.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-21 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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During a telephone conversation with Matthew F. Jodziewicz on October 27, 2005, a provisional election was made with traverse to prosecute the species of the epoxy acrylated oligomer as the polymer and triethyleneglycol dimethacrylate as the monomer, claims 1-8, 10-12, 14-17, 19 and 20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9, 13, 18 and 21 are withdrawn from further under 37 CFR 1.142(b) as being drawn to non-elected species of monomer based on the additional presence of vinyl ether.

2. Independent claims 6, 10, 14 and 19 have both broad proportion ranges of polymer, monomer and/or hydroxycyclohexylphenyl ketone followed by narrower preferred ranges. It cannot be ascertained whether the broad or narrower range is the actual defined proportion. The preferred levels should be deleted and introduced as dependent claims for a more clear denotation of the concentrations.

3. Nowhere in the specification, particularly page 12, the last two lines to page 13, line 1 is there any mention of the vinylether of withdrawn claims 9, 13, 18 and 21. The last two lines of page 12 lists triethylene glycol dimethacrylate alone as required in claim 4. Triethylene glycol divinyl ether is described on page 10, line 1. More favorable consideration would be given to the more concise identification of the vinylether of claims 9, 13, 18 and 21 as the enabled triethyleneglycol divinylether along with the language "wherein said monomer is selected from the group consisting of triethylene glycol dimethacrylate and triethyleneglycol divinylether."

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Such amended subject matter would lead to the reinstatement of the withdrawn claims as active since the new language accommodates the elected species of triethyleneglycol dimethacrylate alone.

4. The photoinitiator "hydroxycyclohexyl phenyl ketone" is misspelled on page 10, line 16 as well as in independent claims 1, 6, 10, 14 and 19.

5. The "CIBA Irgacure 184 Photoinitiator" and "Microveneer Gel" information sheets listed in the Information Disclosure Statement filed June 18, 2005, page 2, have not been considered since they have not been received.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6, 8, 10, 11, 14, 15, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Canadian Patent No. 2,049,633.

6. The Canadian patent on page 3, claim 3, denotes a ultraviolet radiation curable nail polish composition comprising from 50-80 weight percent of an aliphatic urethane acrylate, from 2-21 weight percent of trimethylolpropane ethoxylate triacrylate monomer and from 3-20 weight percent of 1-hydroxycyclohexylphenyl ketone. The aliphatic urethane acrylate is prepared by the reaction of a hydroxyl-terminated polyurethane derived from a polyol and a polyisocyanate which is reacted with acrylic acid.

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The polyurethane portion renders the aliphatic urethane acrylate polymeric and within the confines of the claimed polymer. The epoxy acrylated oligomer of claims 3, 7, 12, 16 and 20 is not recited.

Claims 1-8, 10-12, 14-17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Osawa et al. Patent No. 6,335,079.

7. Osawa et al. (col. 2, lines 25-56) sets forth a radiation curable composition containing from 10-50 parts by weight of the elected species of a bisphenol A epoxy di(meth)acrylate, as little as 20 parts by weight of a blend of monofunctional (meth)acrylate and bifunctional (meth)acrylate, from 1-20 parts by weight of a polymer (col. 4, lines 16-17) and a polymerization initiator (col. 4, lines 25 and 30-31) such as the exemplified 1-hydroxycyclohexylphenyl ketone E1 in an amount of 1% by weight (cols. 5-6, Table 1 and col. 6, line 59).

8. The content of as much as 50 parts by weight of bisphenol A epoxy di(meth)acrylate relative to a minimum of 20 parts by weight of (meth)acrylate monomers and from 1-20 parts by weight of polymer falls within the limits of from 40-90% by weight and preferably from 60-85% of polymer required in independent claims 6 and 19. Both the bisphenol A epoxy di(meth)acrylate and polymer of Osawa et al. are embraced by the claimed polymer. Independent claims 1, 10 and 14 do not define any amount of polymer and is therefore anticipated by patentees regardless of the disclosed proportions.

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9. The claimed natural nail and/or nail tip coating composition is the ultimate intended utility of the claimed blend and is not an affirmative limitation necessitating the coating of a nail. The claimed "sufficient viscosity to be applied to natural nails and artificial nail tips and so as to not run on the nail or nail tip during application" in independent claims 1, 6, 10, 14 and 19 is an ultimate intended feature of the composition once applied to a nail and is not an affirmative limitation. The formulation of Osawa et al. contains components within the claimed polymer and monomer as well as hydroxycyclohexylphenyl ketone which is filled into a mold (col. 5, lines 1 and 44). Accordingly the prior art mixture possesses a viscosity sufficient to be applied to a nail.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-12, 14-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al. Patent No. 6,051,242.

10. Patel et al. sets forth a nail treatment composition (col. 3, lines 9 and 19-30) prepared from about 5% to about 40% by weight (col. 3, lines 31-32 and 34) of a base or lacquer component composed of primary film-former such as an acrylic or vinyl polymer (col. 3, lines 58 and 61), from about 1% to about 30% by weight (col. 3, lines 35-37) of a secondary film-former such as vinyl polymers, polyether urethanes, polyester resins and acrylic polymers (col. 4, lines 28 and 33-35),

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and from about 0.1% to about 20% by weight (col. 3, lines 37 and 39-40) of a reactive species such as a monomer of the elected species of triethylene glycol dimethacrylate (col. 5, line 53). The base or lacquer component is combined with from about 0.5% to about 50% by weight (col. 8, lines 21-27) of a pigment component containing an aromatic ketone (col. 3, lines 31, 28 and 30) such as from about 0.01% to about 1% by weight of 1-hydroxycyclohexylphenyl ketone (col. 9, lines 30, 32 and 34-36).

11. Although Patel et al. does not designate as preferred, nor exemplify the claimed hydroxycyclohexylphenyl ketone, its explicit disclosure renders obvious its use together with the film-forming polymers and monomers.

Claims 1-8, 10-12, 14-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lilley Patent No. 6,481,444 in view of Canadian Patent No. 2,049,633.

12. Lilley et al. reports an actinic radiation curable nail coating (col. 5, lines 48-50 and 56-57) obtained from (meth)acrylate polymers such as between 30-90% by weight of a BISGMA urethane resin (col. 6, lines 48-51 and 59-62, deemed to be a suitable species according to page 11, the second and third paragraphs of the specification) diluted with dimethacrylate monomers such as triethylene glycol dimethacrylate (col. 7, lines 18-20 and 26) and between 0.05-10% by weight of a photoinitiator (col. 6, lines 54 and 64-66).

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13. The claimed hydroxycyclohexylphenyl ketone as the photoinitiator is not recited. The Canadian patent is described hereinabove. It would have been obvious to employ the 1-hydroxycyclohexylphenyl ketone of the Canadian patent as the photoinitiator of Lilley et al. in order to facilitate the flow of the coating onto the nails and to form even surfaces (Canadian patent, page 8, lines 22-25).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
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